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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,187	12/17/2001	Juergen Hoffmann	5005.1013	3352
23280	7590	09/08/2004	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC			PYO, KEVIN K	
485 SEVENTH AVENUE, 14TH FLOOR			ART UNIT	
NEW YORK, NY 10018			PAPER NUMBER	
			2878	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,187

Applicant(s)

HOFFMANN, JUERGEN

Examiner

Kevin Pyo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/24/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “31” in Fig.2 has been used to designate both a scanning mirror and a dichroic beam splitter.
2. The drawings are objected to because a lens provided between a light source (17) and a dichroic beam splitter (25) in Fig.2 was not given any reference character.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 1-11 are objected to because of the following informalities:
 - In claim 1, line 1, “Scanning” is changed to --scanning--.
 - In claim 1, line 2, “At” is changed to --at--.
 - In claim 2, line 1, “Scanning” is changed to --scanning--.
 - In claim 3, line 1, “Scanning” is changed to --scanning--.

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In claim 4, line 1, "Scanning" is changed to --scanning--.

In claim 5, line 1, "Scanning" is changed to --scanning--.

In claim 6, line 1, "Scanning" is changed to --scanning--.

In claim 7, line 1, "Scanning" is changed to --scanning--.

In claim 8, line 1, "Scanning" is changed to --scanning--.

In claim 9, line 1, "Scanning" is changed to --scanning--.

In claim 10, line 1, "Scanning" is changed to --scanning--.

In claim 11, line 1, "Scanning" is changed to --scanning--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hell et al (5,731,588).

Regarding claim 1, Hell et al shows in Fig.1 the following elements of applicant's invention: a) at least one light source for generating an excitation light beam of a first wavelength and an emission light beam of a second wavelength (col.3, lines 27-33); b) microscope optics (6, 22, 5, 4) for focusing the exciting light beam onto a first focal region in a first plane of a sample and for focusing the emission light beam onto a second focal region in a

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second plane of the sample, whereby the excitation light beam optically excites the sample in the first focal region and the emission light beam generates stimulated emission in the second focal region and whereby the first and second focal regions are overlapping at least partially (col.2, lines 18-25), said light source (2, 3) and said microscope optics (6, 22, 5, 4) defining an illumination beam path (Fig.1); c) means for scanning the excitation light beam and the emission light beam onto a sample (a beam raster device 11 inherently includes a scanning mirror); and d) components for guiding and shaping (13) being arranged in the illumination beam path, whereby optical properties of the components and of the microscope optics are matched to one another such that the optical aberrations are corrected in such a way that the focal regions remain static relative to one another irrespective of the scanning movement (col.6, lines 16-19).

Regarding claim 2, the lens (13) with the different lengths of the optical paths from the first and second light sources (2 and 3) would correct axial chromatic aberration.

Regarding claims 4 and 8, Hell et al discloses optical correction means (13).

Regarding claim 6, the limitation therein is shown in Fig.1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 5, 7, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hell et al.

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Regarding claim 3, the specific type of aberration being corrected would have been obvious to one of ordinary skill in the art at the time of the invention in view of the desired performance.

Regarding claims 5 and 7, the specific placement and configuration of an optical correction means would have been obvious to one of ordinary skill in the art at time of the invention in view of the desired performance.

Regarding claims 9-11, the specific correction means utilized would have been obvious to one of ordinary skill in the art at the time of the invention in view of design requirements and the desired performance.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Pyo whose telephone number is (571) 272-2445. The examiner can normally be reached on Mon-Fri (with flexible hour), First Mon. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kevin Pyo', written in a cursive style.

Kevin Pyo
Primary Examiner
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Pkk
9/2/04